CERTIFICATE OF TRANSMITTAL

I hereby certify that on **January 26, 2009**, this paper (along with any paper referred to as being attached or enclosed) is being transmitted through the EFS system via the United States Patent and Trademark Office website at http://www.uspto.gov.

Kathy Hinckley

**PATENT**

| | |
|---|---|
| Applicant: | Brian J. Cox |
| Serial No.: | 10/763,975 |
| Filed: | January 22, 2004 |
| Title: | **ANEURYSM TREATMENT DEVICE AND METHOD OF USE** |
| Examiner: | Severson, Ryan J. |
| Group Art Unit: | 3731 |
| Confirmation No.: | 7891 |
| Atty. Docket No.: | 388700-058B |

# IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
# BOARD OF PATENT APPEALS AND INTERFERENCES

## REPLY BRIEF UNDER 37 CFR § 41.41

Mail Stop Appeal Brief-Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

In response to the Examiner's Answer mailed November 26, 2008 ("*Examiner's Answer*") (Attached as Exhibit 1), please consider the Reply Brief contained herein. It is believed that this Reply Brief addresses all outstanding issues; that entry of this Reply Brief is proper; and that the preparation and mailing of a Decision On Appeal is now in order.

The fee of $510 for filing an Appeal Brief has previously been paid. The Commissioner is authorized to charge any additional filing fees or credit any overpayment to Deposit Account No. 50-2809.

## REAL PARTY IN INTEREST

The real party in interest is MicroVention, Inc., a Delaware corporation having a place of business at 75 Columbia, Suite A, Aliso Viejo, CA 92656. MicroVention, Inc. is the Assignee of all rights in the application.

## RELATED APPEALS AND INTERFERENCES

There are currently no appeals or interferences known to the Appellant, the Appellant's legal representative, or assignee which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

## STATUS OF CLAIMS

Claims 23-28, 40, and 41 are currently pending. Claims 29-39, 42, and 43 were previously withdrawn from consideration, and claims 1-22 were previously canceled. Claims 23-28, 40, and 41 stand rejected and are currently under appeal.

## GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

Whether claims 23-28, 40, and 41 of the present application are unpatentable under 35 U.S.C. §103(a) over U.S. Patent No. 6,231,597 to Deem et al. in view of U.S. Patent No. 5,234,456 to Silvestrini.

## APPELLANT'S RESPONSES TO THE EXAMINER'S ANSWER

At issue in the present Appeal is the Examiner's contention that the deficiency of U.S. Patent No. 6,231,597 to Deem et al. ("*Deem et al.*") (Attached as Exhibit 2) to teach the invention as claimed in claims 23 and 40 are overcome by the teachings of U.S. Patent No. 5,234,456 to Silvestrini ("*Silvestrini*") (Attached as Exhibit 3). More specifically, whether *Silvestrini* makes up for the deficiency of *Deem et al.* to teach or make obvious the Appellant's claimed reactive material being expanded when in a reacted state such that the reactive material restricts flow of blood to the vascular aneurysm when the reactive material is in the reacted state.

### I. APPELLANT'S RESPONSES REGARDING THE EXAMINER'S AMENDED GROUNDS OF REJECTION

In the Grounds of Rejection section of the *Examiner's Answer*, the Examiner restates the rejection as provided in the Final Office Action in its entirety, and further added the following assertion:

> In addition, Examiner asserts that it would have been obvious to replace the cover (102) of Deem et al. with the hydrophilic material (26) of Silvestrini to help occlude the neck of an aneurysm. Such a substitution would have the hydrophilic material (26) of Silvestrini woven about the support structure of Deem et al.

At p. 5, lines 14-18 (Cited page numbers are with reference to the Appellant's page numbers provided at the *bottom* of each page of Exhibit 1.).

#### A. THE EXAMINER'S DESCRIPTION OF THE EXAMINER'S PROPOSED MODIFICATION OF THE PRIOR ART IS INCONSISTENT AND UNCLEAR.

Due to certain inconsistencies in the Examiner's responses, the exact nature of the Examiner's proposed modification of the prior art remains unclear. In asserting the general rejection, the Examiner has stated:

> Attention is drawn to Silvestrini, who teaches a stent or similar structure (for example, see figure 3) can be partially made of a material that is inert or solid (28) and partially made of a material that is *expandable (26)*. Therefore, it would have been obvious . . . to make the covering (102) of Deem et al. of the *hydrophilic material (26)* of Silvestrini. . . . In addition, Examiner asserts that it would have been obvious to replace the cover (102) of Deem et al. with the *hydrophilic material (26)* of Silvestrini. . . . Such a substitution would have the *hydrophilic material (26)* of Silvestrini woven about the support structure of Deem et al.

*Examiner's Answer* at p. 5, lines 8-18 (Emphasis added). In the Response to Argument section of the *Examiner's Answer*, the Examiner further remarks that the "Examiner proposed using the expandable material of Silvestrini (which necessarily includes the filler material and the membrane)." At p. 7, lines 18-21.

Inconsistencies arise in the Examiner's rejection from the fact that *Silvestrini* teaches, "[t]he ***hollow fibers 26*** have disposed therein a hydrophilic material, as described above in relation to FIG. 1." *Id.* at p. 5, column 3, lines 48-50 (Emphasis added.). With respect to FIG. 1, *Silvestrini* teaches that the "***hydrophilic material 32***" can be any bio-compatible agent that will drive an osmotic pressure. Examples include . . . inorganic salt, organic salt, sugar, poly sacchrides, polymeric hydrogels, or amphoteric molecules." At p. 3, column 2, lines 42-47. Upon even a cursory review of *Silvestrini*, one of ordinary skill in the art would recognize that the hollow fibers 26 and the hydrophilic material 32 are distinct elements serving different functions.

On the one hand, the Examiner appears to be asserting that it would have been obvious to make or replace the cover 102 of *Deem et al.* with only one of the elements taught by *Silvestrini*. However, it is unclear exactly to which element of *Silvestrini* the Examiner's "hydrophilic material (26)" is referencing, as such an element is not disclosed by *Silvestrini*. On the other hand, the Examiner appears to refer to the hollow fibers 26 and the hydrophilic material 32 collectively as "the expandable material of Silvestrini."

Clarification of the Examiner's rejection is respectfully requested, and the Applicant requests to reserve the right to supplement the Applicant's responses based upon such clarification. In order to advance the present Appeal, the Applicant's responses contained herein are based on the assumption that the Examiner's proposed modification of the prior art includes making or substituting the cover 102 of *Deem et al.* with the hollow fibers 26 containing the hydrophilic material 32 of *Silvestrini.*

**B. THE EXAMINER HAS MISAPPREHENDED THE PRIOR ART AND INCORRECTLY APPLIED IT AGAINST THE CLAIMED INVENTION.**

The Examiner has misapprehended the prior art and incorrectly applied it against the Appellant's claimed invention. The Examiner's rejection as it relates to the Appellant's claimed reactive material is as follows: (1) *Deem et al.* teach a bridge or occlusion portion that includes a reactive material 102; (2) the reactive material of *Deem et al.* does not expand when in a reacted state, however, *Silvestrini* teaches a stent or similar structure that can be partially made of a material that is expandable; therefore, (3) it would have been obvious to make the covering 102 of *Deem et al.* of the hydrophilic material 26 of *Silvestrini* to allow the reactive material to expand and help occlude the aneurysm. *Examiner's Answer* at p. 4, lines 9-11 and p. 5, lines 8-14. This line of argument is incorrect for at least two reasons.

First, the Examiner's assertion that *Deem et al.* teach a bridge or occlusion portion that includes a "reactive material 102" is incorrect. The Examiner supported the assertion that the bridge or occlusion portion includes a reactive material 102 by citing to *Deem et al.* at page 9, column 5, lines 49-55. *Examiner's Answer* at p. 4, lines 9-11. In this passage, *Deem et al.* simply teach that the cover 102 may comprise a typical graft material, such as polyester or PTFE and that when the stent 101 is deployed in the vessel of a patient, the cover 102 is oriented to span the abnormality to promote clotting and endothelial growth. At page 9, column 5, lines 49-55. One of ordinary skill in the art at the time of the invention would understand that polyester and PTFE are materials commonly recognized as being inert in the human body, hence their use in grafts. The

Examiner's confusion may arise from *Deem et al.* teaching that the cover 102 "promotes clotting and endothelial growth." *See id.*

However, one of ordinary skill in the art at the time of the invention would understand that mere placement of the stent 101 including the cover 102 over the neck of an aneurysm was postulated to sufficiently alter the hemodynamics and induce ***spontaneous clotting*** of stagnant blood within the aneurysm dome. *Id.* at p. 7, column 2, lines 53-60 (Citing Wakhloo, AK, Schellhammer, F, de Vries, J, Haberstroh, J, Schumacher, M, *Self-Expanding and Balloon-Expandable Stents in the Treatment of Carotid Aneurysms: An Experimental Study In a Canine Model,* 15 Am J Neuroradiol 493 (1994)). Similarly, mere placement of a structure such as the stent 101 having the cover 102 across the neck of an aneurysm was postulated to provide a lattice for growth of new endothelial cells across the aneurysm neck. *Id.* Hence, one of ordinary skill in the art at the time of the invention would understand that the blood and endothelium of the vessels would react to the presence of the cover 102—not that the polyester or PTFE cover 102 would be reactive per se. Therefore, the foundation of the Examiner's obviousness rejection is based on an incorrect premise: that the cover 102 of *Deem et al.* is reactive. Since the cover 102 is not reactive, one of ordinary skill in the art at the time of the invention searching for alternative materials for cover 102 might substitute other similar non-reactive materials, but, in the absence of any teaching or motivation in the prior art, would have no reason to substitute a reactive material. The Examiner has thus failed to properly address how the prior art teaches or makes obvious the Appellant's claimed reactive material.

Second, the Examiner failed to properly interpret the claimed invention in light of the cited prior art. Claim 23 recites, in part, said bridge portion including a reactive material, said reactive material being expanded when in a reacted state. Claim 40 recites, in part, said occlusion region including a reactive material, said reactive material being expanded when in a reactive state. The Appellant notes that the Examiner has properly interpreted the Appellant's invention in so far as the Examiner has treated the terms "reactive" and "expanded" as two distinct features of the "material". *See*

*Examiner's Answer* at p. 4, lines 9-11 and p. 5, lines 8-14. However, the Examiner has failed to appreciate that both of these features, reactivity and expandability, are claimed as features of the same material. To the contrary, the Examiner has asserted that the reactive feature of the claimed material was taught by a first element, the cover 102 of *Deem et al.*, albeit incorrectly as discussed above, and that the expandable features of the claimed material was taught by a distinct second and third element, the hollow fibers 26 containing the hydrophilic material 32 of *Silvestrini*.

The Examiner asserted that it would have been obvious to make or replace the cover 102 of *Deem et al.* with the hollow fibers 26 containing the hydrophilic material 32 of *Silvestrini*. *See* above section *A. The Examiner's Description of the Examiner's Proposed Modification of the Prior Art Is Inconsistent and Unclear.* However, the Examiner is relying upon the cover 102 to make obvious the claimed feature of reactivity *and*, separately, the hollow fibers 26 containing the hydrophilic material 32 to make obvious the claimed feature of expandability. Making or substituting out the cover 102 for the hollow fibers 26 containing the hydrophilic material 32 removes from the Examiner's proposed device the Examiner's only support for the obviousness of the claimed reactive material. Accordingly, the Examiner has failed to establish that this element of the Appellant's invention is made obvious by the cited prior art.

## II. APPELLANT'S RESPONSES TO EXAMINER'S ARGUMENTS

In the Appeal Brief, the Appellant argued that the Examiner failed to establish a *prima facie* case of obviousness, because (1) the Examiner failed to articulate a rationale underpinning why the Appellant's invention would have been obvious; and (2) the Examiner's proposed modification of the prior art improperly changes the principle of operation of the prior art device.

### A. Appellant's Responses to the Examiner's Arguments Regarding The Examiner's Failure to Articulate a Rationale Underpinning the Obviousness Rejection

In response to the Appellant's argument that the Examiner has failed to provide a clearly articulated rationale as to why the claimed invention would be obvious, the Examiner first responded by stating:

> [T]he Final Rejection clearly states the advantage of using the material of Silvestrini, particularly that an expandable material is capable of expanding and further helping to occlude an aneurysm neck. An expandable material can expand and conform to the structural shape that the material is deployed in. In this case the expandable material, when placed on the stent structure of Deem et al., can expand and conform more completely to the vessel walls and aneurysm opening than a material that is non-expandable.

*Examiner's Answer* at p. 6, lines 8-14. The gist of this argument appears to be that the proposed substitution of the cover 102, taught by *Deem et al.*, with the hollow fibers 26 containing the hydrophilic material 32, taught by *Silvestrini*, would some how improve the stent 101 taught by *Deem et al.* and, therefore, that this advantage renders the presently claimed invention obvious.

The Examiner's entire argument is based on (1) an assumption that the stent 101 of *Deem et al.* would be improved by increasing the cover's 102 ability to conform and (2) a comparison of the suitability of two different materials to perform a specific function, that is to say, a comparison of the ability of the *Deem et al.* cover 102 and the *Silvestrini* hollow fibers 26 containing the hydrophilic material 32 to restrict flow into an aneurysm while minimizing flow restriction within the vessel. *See Deem et al.* at p. 9, column 5, lines 18-22 (Describing the function of the cover 102). Notably absent in the Examiner's argument is any form of support for the Examiner's assumption and any form of rationale as to how one of ordinary skill in the art at the time of the invention would have been able to make an informed comparison of the prior art materials.

With respect to the Examiner's assumption that the stent 101 of *Deem et al.* would be improved by increasing the "conformity" of cover 102, the Examiner has simply concocted the alleged desirability of increased conformity for the cover 102 of the stent 101 of *Deem et al.* *Deem et al.* teach nothing regarding the ability or desirability of cover 102 to conform to the vessel wall. *Deem et al.* simply teach that "cover 102 is oriented to span the abnormality to promote clotting and endothelial growth." At p. 9, column 5, lines 53-55. Interestingly, the only discussion regarding a desirability of any stent, or an element of a stent, t*o conform to the interior of a vessel* is found in the Appellant's present application at page 19, lines 13-16, with reference to the embodiments illustrated in FIGS. 6-9, a strong indication that the Examiner has improperly resorted to hindsight.

Furthermore, even if it were assumed, for the sake of argument, that increasing the conformity of cover 102 would be a desirable feature, the Examiner's comparison of the physical characteristics of the cover 102 and the hollow fibers 26 containing the hydrophilic material 32 is baseless. The Examiner's fundamental argument is that an expandable material will conform more completely to a vessel wall and aneurysm opening than a material that is non-expandable. *Examiner's Answer* at p. 6, lines 8-14. However, one of ordinary skill in the art would understand that a material's pliability, or ability to conform, is a highly variable characteristic and not simply a function of whether the material is expandable or non-expandable.

For example, in a design such as that of *Silvestrini*, which employs the hollow fibers 26 containing the hydrophilic material 32, the pliability of the expanded hollow fiber 26 would, in part, be a function of the osmotic pressure generated by the hollow fibers 26 containing the hydrophilic material 32, as well as the hollow fibers' 26 ability to resist rupture. *Silvestrini* at p. 4, lines 48-53 and p. 3, lines 31-47. An expandable design generating a low osmotic pressure would result in less solution entering the hollow fiber 26 and thereby yield a relatively softer, more pliable expanded hollow fiber 26. On the other hand, a design generating a high osmotic pressure would result in more solution entering the hollow fiber 26 and thereby yield a firmer, less pliable

expanded hollow fiber 26. With respect to non-expandable materials, such as the cover 102 of *Deem et al.*, the pliability of these materials would depend on a variety of factors such as the chemical composition of the material, the thickness of the material, the amount or degree of support to which the material is attached, and the porosity of the material, i.e. whether the material is perforated or non-perforated.

Neither *Deem et al.* nor *Silvestrini* teach details sufficient to enable one of ordinary skill in the art to quantify or otherwise draw meaningful comparisons regarding the pliability, or lack thereof, of the cover 102 and the hollow fibers 26 containing the hydrophilic material 32. As correctly pointed out by the Examiner, *Deem et al.* are silent as to even the basic characteristics of cover 102, such as whether the cover 102 is solid or impermeable. *Examiner's Answer* at p. 6, line 21 through p. 7, line 1. The Examiner's conclusion that expandable materials conform more completely to the vessel walls and aneurysm opening than non-expandable materials is neither supported by the cited prior art nor an inherent characteristic of these classes of materials. For example, a piece of cellophane draped over a plate would obviously conform to the surface of the plate more than an inflated balloon placed upon the same plate. At least for this reason, the Examiner has failed to provide a clearly articulated rationale underpinning his legal conclusion of obviousness and, hence, has failed to establish a *prima facie* case of obviousness for claims 23 and 40 as required by section 2142 of the *M.P.E.P.*

Next, the Examiner responded to the Appellant's arguments by characterizing the rationale for the rejection as a matter of "selecting a known material (the expandable material taught by *Silvestrini)* on the basis of its suitability for the intended use (for use with stents) as a matter of obvious design choice." *Examiner's Answer* at p. 6, lines 15-19 (Paraphrasing *In re Leshin* 277 F.2d 197 (C.C.P.A. 1960)). This characterization is incorrect for at least two reasons.

First, the Examiner's definition of the *intended use* as "for use with stents" is overly broad. At page 20, lines 5-25 of the present application as filed, the Appellant

describes the intended use of the reactive material as for occluding or otherwise inhibiting the flow of blood to the aneurysm. The Examiner's characterization of the intended use as "for use with stents" would be analogous to characterizing the microprocessor of an automotive anti-lock brake system as *a microprocessor for use with cars*. Obviously, one of ordinary skill in the art would recognize that the intended use and functionality of a microprocessor for an automotive anti-lock brake system would not be generically the same as all other microprocessors for use within an automobile. Accordingly, the appropriate *intended use* in the present situation would be for occluding or otherwise inhibiting the flow of blood to the aneurysm while minimizing the obstruction of flow through the healthy vessel.

Second, the Examiner has provided no evidence or rationale supporting the *suitability* of the hollow fibers 26 containing the hydrophilic material 32, taught by *Silvestrini*, as a material for occluding or otherwise inhibiting the flow of blood to the aneurysm. While the hollow fibers 26 containing the hydrophilic material 32 of *Silvestrini* are taught for use with stents, *Silvestrini* employs the hollow fibers 26 containing the hydrophilic material 32 as a structural and transformative element of the stents 10, 20, and 40. *Silvestrini* at p. 3, column 2, lines 48-58; p. 4, column 3, lines 57-65; and p. 4, column 4, lines 40-54. The hollow fibers 26 containing the hydrophilic material 32 facilitate transformation of the stents 10, 20, and 40 from a compact deployable state to an expanded deployed state. *Id.* Significantly, *Silvestrini* fails to provide any specific details regarding how the hollow fibers 26 containing the hydrophilic material 32 actually expand. One of ordinary skill in the art would understand that fiber expansion could result in an increase in the circumference of the hollow fiber 26, an increase in length of the hollow fiber 26, or an increase in some combination of the circumference and the length of the hollow fiber 26. However, such details regarding the expansion of the hollow fibers 26 containing the hydrophilic material 32 are simply not taught. Based on the present record, conclusions regarding the suitability of the hollow fibers 26 containing the hydrophilic material 32 for occluding

or otherwise inhibiting the flow of blood to a aneurysm would amount to little more than conjecture.

Even if it is assumed, for the sake of argument and without concession, that the present rejection is correctly characterized as a simple substitution of one known element for another, the Examiner has failed to provide a finding that the result of the proposed substitution would have been predictable to one of ordinary skill in the art. As provided by the *M.P.E.P.* at § 2143 B(3), the rationale to support a conclusion that the claims would have been obvious as a "simple substitution of one known element for another" must include a finding that the result of the substitution would have been predictable to one of ordinary skill in the art. The sole rationale for the rejection provided by the Examiner is that the hollow fibers 26 containing the hydrophilic material 32 would conform to a vessel wall better than the cover 102, yet this fails to address how the results of the Examiner's proposed substitution would have been predictable. Nor could one of ordinary skill in the art predicted the results of the proposed substitution based upon the teachings of the prior art or common knowledge. As discussed above, *Silvestrini* teaches nothing regarding how the dimensions of the hollow fibers 26 containing the hydrophilic material 32 actually change when the fibers 26 are expanded, e.g. whether there is expansion in fiber circumference and/or fiber length. Whether or not there would be a circumferential expansion in the hollow fiber 26 would be material in order for one of ordinary skill in the art to predict the results of the Examiner's proposed substitution.

**B. APPELLANT'S RESPONSES TO THE EXAMINER'S ARGUMENTS REGARDING THE EXAMINER'S PROPOSED MODIFICATION IMPROPERLY CHANGING THE PRINCIPLE OF OPERATION OF THE PRIOR ART DEVICE.**

In responding generally to the Appellant's argument that the Examiner's proposed modification of the prior art would change the principle of operation of the prior art device, the Examiner described that the substitution would include weaving the hollow fibers 26 containing the hydrophilic material 32 of *Silvestrini* about the support

structure of *Deem et al.* *Examiner's Answer* at p. 5, lines 14-18 and page 7, lines 20-21.

The Examiner also stated that the "Examiner at no point has suggested the stent of Deem et al. be used for any purpose other than deployment in a blood vessel at the site of an aneurysm." *Id.* at page 6, lines 14-16. In light of the fact that the Appellant has never argued that the Examiner *had* suggested any specific use of the stent of *Deem et al.*, the basis and intent of the Examiner's remark is unclear. The Appellant requests to reserve the right to respond to this remark upon clarification of the remark by the Examiner.

The Examiner's substitution would impermissibly change the principle of operation of the device of *Deem et al.* The purpose of the stent 101 of *Deem et al.* is to obstruct flow to an aneurysm while simultaneously minimizing obstruction of flow through the healthy vessel. At p. 9, column 5, lines 18-22. The principle of operation of the stent 101 is simply to span the vascular abnormality, or aneurysm, by deployment of the stent at the site of interest and orientation of the predisposed cover 102 so as to block the vascular abnormality. *Id.* at p.9, column 5, lines 45-54.

If one were to make the material substitution, as the Examiner suggests, a person of ordinary skill in the art at the time of the invention would easily recognize that the proposed modification would necessitate a redesign of the stent 101 of *Deem et al.* For example, from a cross-sectional perspective, the Examiner's proposed modified cover would employ a first layer comprising a semi-permeable membrane made of a material such as polyester; a second layer comprising a hydrophilic, expandable material; and a third layer comprising an additional semi-permeable membrane made of a material such as polyester. *Silvestrini* at p. 3, column 2, lines 31-37. Furthermore, the Examiner stated that the hollow fibers 26 containing the hydrophilic material 32 would be woven about the support structure of *Deem et al.* While it is unclear if the Examiner intends the hollow fibers 26 containing the hydrophilic material 32 to only be woven about the support structure or also to be woven about one another, i.e. to form a lattice-

type structure, at certain locations, the above described cross-section would at least also include an additional layer representing the support structure of the stent 101 of *Deem et al.*

In contrast, *Deem et al.* teach that the cover 102 may comprise a typical graft material, such as polyester, and that it may be applied to an exterior or interior of elements 14 using a biocompatible adhesive or sutures. At p.9, column 5, lines 49-52 and FIG. 4. From a cross-section perspective, the cover includes a single layer of a material such as polyester and at certain locations an additional layer representing the support structure of the stent 101 of *Deem et al. Id.* One of ordinary skill in the art would recognize the basic principle that a single layer of typical graft material such as polyester would comprise less material and thereby occupy less volume, i.e. be thinner, than two layers of a similar polyester material sandwiching an additional layer of an expandable material. The increased thickness of the modified cover proposed by the Examiner would effectively decrease the internal diameter of the stent 101 of *Deem et al.*, and the stent would no longer function to minimize obstruction of flow through the healthy vessel, as intended by *Deem et al.* In order to accommodate the increased thickness of the Examiner's proposed modified cover while still minimizing obstruction of flow through the healthy vessel, the Examiner's proposed modification would require design and construction changes to compensate for the expansion and/or thickening of the modified cover. These changes in the principle of operation, design, and construction of the stent 101 of *Deem et al.* are evidence that the teachings of *Deem et al.* and *Silvestrini* are insufficient to establish the Examiner's *prima facie* case of obviousness.

Finally, in response to the Appellant's above line of argument, the Examiner also stated that "Silvestrini at no point discloses or teaches the material, when expanded, would occlude the internal diameter of the stent." *Examiner's Answer* at p. 8, lines 3-5. The Appellant agrees with the Examiner's remark. However, the point is irrelevant in light of the fact that the Examiner's proposed modification would utilize the hollow fibers 26 containing the hydrophilic material 32 of *Silvestrini* in a manner entirely distinct from

and for a different purpose than that taught by *Silvestrini*. *Silvestrini* employs the hollow fibers 26 containing the hydrophilic material 32 as a structural and transformative element of the stents 10, 20, and 40. At p. 3, column 2, lines 48-58; p. 4, column 3, lines 57-65; and p. 4, column 4, lines 40-54. In contrast, the Examiner's proposed modification would employ the hollow fibers 26 containing the hydrophilic material 32 as a non-structural, non-transformative element for covering, restricting, or otherwise occluding flow into an aneurysm. Again, these differences beg the question as to what would have been the motivation and reason for one of ordinary skill in the art at the time of the invention to replace the already functioning cover 102 of *Deem et al.* with the dissimilar materials used for a dissimilar function of *Silvestrini*.

## IV. CONCLUSION

For at least all the reasons stated herein, it is submitted that the Examiner's rejection is erroneous. As a result, the Appellant's seek a reversal of the Examiner's rejection on this appeal. Reversal is hereby affirmatively requested.

Respectfully submitted,

Dated: January 26, 2009

Shane S. Swanson, Esq.
Registration No. 52,263

INSKEEP INTELLECTUAL PROPERTY GROUP, INC.
Inskeep Intellectual Property Group, Inc.
2281 W. 190th Street, Suite 200
Torrance, CA 90504
Phone: 310-755-7800
Fax: 310-327-3466

*Customer No. 37,374*